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EXAMINER

SUBRAMANIAN, NARAYANSWAMY

ART UNIT PAPER NUMBER

3624

DATE MAILED: 05/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/971,878

Applicant(s)

LE ET AL.

Examiner

Narayanswamy Subramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 10 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. Original claims 1-10 have been examined. The restriction and rejections are stated below.

#### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Invention I: The claims 1-9 are drawn to a method of conducting an international transaction in goods, classified in class 705, subclass 37.

Invention II: The claim 10 is drawn to a method of conducting an international transaction in goods including the steps of querying a procurement module to solicit bids from suppliers for and contract manufacturers for the manufacture of the goods, classified in class 705, subclass 37.

3. Inventions I and II are related as sub combinations disclosed as usable together in a single combination. The sub combinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as conducting an international transaction in goods between a buyer having a destination location for the goods and a seller of the goods having a selling location for the goods without using the steps of querying a procurement module to solicit bids from suppliers for and contract manufacturers for the manufacture of the goods recited in invention II. See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Following a telephone call to the office of Mr. John A. Griecchi on April 17, 2003 a provisional election was made without traverse to prosecute Invention I pertaining to claims 1-9.

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Affirmation of this election must be made by applicant in replying to this Office action. Claim 10 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pool et al (US Patent 6460020 B1).

With reference to claim 1, Pool teaches a method of conducting an international transaction in goods between a buyer having a destination location for the goods and a seller of the goods having a selling location for the goods, comprising: identifying a source country for the seller's goods and a buying country for the buyer's destination for the goods (See Pool Column 7 lines 28-30 and Column 8 lines 8-10); querying a shipping module to calculate a total shipping cost for shipping the goods along a shipping route to the service level (See Pool Column 7 lines 28-34); querying a brokering module to calculate a total brokering cost for brokering the goods along the shipping route (See Pool Column 11 lines 61-66 and Column 12 lines 55-58); querying a tax module to calculate a total tax cost for the sale and transportation of the goods (See Pool Column 7 lines 28-34); providing a total cost to the buyer, the total cost including a sale price, the total shipping cost, the total brokering cost and the total tax cost (See Pool Column

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8 lines 45-50 and Column 12 lines 56-58); receiving authorization to conduct the transaction (See Pool Column 3 lines 49-51); transmitting shipping instructions to a carrier (See Pool Column 11 lines 53-60); and transmitting customs invoice information to a customs broker (See Pool Column 11 lines 61-65). The step of querying and the step of calculating the total brokering cost are inherent in the disclosure of Pool.

With reference to claim 2, Pool discloses a method of claim 1 as discussed above.

Pool does not explicitly teach the step of transmitting manufacture instructions upon receiving authorization to conduct the transaction.

Official notice is taken that the step of transmitting manufacture instructions upon receiving authorization to conduct the transaction is old and well known in the art. This is especially common for custom-made goods and for products that are ordered in large quantities (larger than the conventional inventory carried by the manufacturer). Such instructions help the buyer get the products made to their specification and help the manufacturer save on inventory costs.

It would have been obvious to one with ordinary skill in the art at the time of invention to include the step of transmitting manufacture instructions upon receiving authorization to conduct the transaction to the disclosure of Pool. The combination of the disclosures taken as a whole suggests that it would have helped the buyer get the products made to their specification and it would have helped the manufacturer save on inventory costs.

With reference to claim 3, Pool discloses a method of claim 1 wherein the step of transmitting the shipping instructions includes reciting the total shipping cost calculated in the step of querying a database of shipping information (See Pool Column 7 lines 28-34).

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With reference to claim 4, Pool discloses a method of claim 1 wherein the step of transmitting a customs invoice includes reciting the total brokering cost calculated in the step of querying a database of brokering information (See Pool Column 7 lines 5-10). The forwarding charges are interpreted to include the total brokering cost.

With reference to claim 5, Pool discloses a method of claim 1 as discussed above.

Pool does not explicitly teach the steps of receiving and tracking status updates regarding the status of the goods in transit and providing status reports in response to status requests from the buyer.

Official notice is taken that the steps of receiving and tracking status updates regarding the status of the goods in transit and providing status reports in response to status requests from the buyer are old and well known in the art. These steps help the buyer keep track of the goods they are expecting to receive and take appropriate action if there are delays.

It would have been obvious to one with ordinary skill in the art at the time of invention to include the steps of receiving and tracking status updates regarding the status of the goods in transit and providing status reports in response to status requests from the buyer to the disclosure of Pool. The combination of the disclosures taken as a whole suggests that it would help the buyer keep track of the goods they are expecting to receive and take appropriate action if there are delays.

With reference to claim 6, Pool discloses a method of claim 1 wherein the authorization to conduct the transaction is received from the buyer after the step of providing a total cost to the buyer (See Pool Column 3 lines 46-51).

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6. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pool et al (US Patent 6460020 B1) in view of Dutta et al (US Patent 2003/0061058 A1).

With reference to claims 7-9, Pool teaches a method of claim 6 as discussed above including the step of transmitting messages to relevant legal compliance modules configured to track legal compliance information for subsequent reporting to relevant national governments (See Pool Column 10 lines 25-33)

Pool does not explicitly teach the steps of querying to identify any national restrictions that would make the transaction illegal and notifying all parties if the transaction is identified as illegal and transmitting an authorization to bill to a billing module upon receipt of a proof of delivery.

Dutta discloses the steps of querying to identify any national restrictions that would make the transaction illegal (See Dutta Page 2 Paragraph 22). Official notice is taken that the steps of notifying all parties if the transaction is identified as illegal and transmitting an authorization to bill to a billing module upon receipt of a proof of delivery are old and well known in the art. Notifying all parties if the transaction is identified as illegal provides a reason to the buyer as to why the transaction cannot be completed and transmitting an authorization to bill to a billing module upon receipt of a proof of delivery protects the buyer from fraudulent sellers or sellers who may not deliver what they promised.

It would have been obvious to one with ordinary skill in the art at the time of invention to include the steps of querying to identify any national restrictions that would make the transaction illegal and notifying all parties if the transaction is identified as illegal and transmitting an authorization to bill to a billing module upon receipt of a proof of delivery to the disclosure of

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Pool. The combination of the disclosures taken as a whole suggests that it would help all concerned parties avoid illegal transactions and provide a reason to the buyer as to why the transaction cannot be completed. Transmitting an authorization to bill to a billing module upon receipt of a proof of delivery protects the buyer from fraudulent sellers or sellers who may not deliver what they promised.


*Conclusion*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703) 305-7687.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

N. Subramanian  
April 27, 2003

 Richard Weisberger  
Primary Examiner